

### **REMARKS**

Applicant hereby replies to the Office Action dated September 7, 2009, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

#### **Status of Claims**

After this amendment, claims 20-42 are currently pending. Claims 20, 28 and 32 are independent.

Claims 20-34 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,758,257 (“Herz”) in view of U.S. Patent No. 5,945,988 issued to Williams (“Williams”). Claims 35 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz in view of Williams, and further in view of U.S. Patent No. 7,152,236 issued to Wugofski (“Wugofski”).

#### **Claim Amendments**

Claims 20, 28 and 32 are amended. New claims 38-42 are added. Applicant notes that support for the amended and new limitations is given in at least paragraphs [3263] – [3295] of the published application. No new matter has been added.

**Rejections under 35 U.S.C. § 103(a)**

*Claims 20-34 and 36*

Rejection of claims 20-34 and 36 is respectfully traversed because, for at least the following reasons, Herz and Williams, whether considered separately or in combination, fail to show or suggest all of the claimed limitations.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, "[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*." And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, "[t]he mere fact that references can be combined or modified does not render the

resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007).

Additionally, according to MPEP §2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Amended independent claim 20 requires, in part, “presenting the viewer with a second list including alternative TV programs available for viewing, the alternative programs selected in accordance with an alternative viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer, wherein the feedback is based on the viewer answering a query*” (emphasis added). Amended independent claim 28 requires, in part,

presenting the viewer with one of a first list of the selected programs and an alternative second list of programs, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer, wherein the second list is based on feedback input from the viewer of the first list resulting from a query* (emphasis added).

Amended independent claim 32 requires, in part, “presenting the viewer with a second list of selected programs based on said feedback input, *the second list arranged in accordance with an alternate viewer characteristics information profile, wherein the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer after receiving the feedback input from the viewer based on the query*” (emphasis added). By contrast, Herz in view of Williams fail to teach or suggest these limitations.

Herz discloses that customer profiles are updated based on whether a show that was predicted to be watched by a viewer was not watched (Herz, col. 26, line 64-col. 27, line 1). The updating of the profile is done by use of passive monitoring (Herz, col. 26, line57-60). Based on the passive monitoring, if the profile of the user is modified, a program viewing list in Herz is modified to create a new replacement list. Therefore, the “feedback” from a user in Herz must be input based on the passive monitoring by a viewer. Thus, the viewer does not enter feedback input after the viewer views a first list as the viewer in Herz simply watches a show or does not watch a show. Further, as passive monitoring is used in Herz, the viewer is not requesting anything. In contrast, the feedback in Applicant’s claimed invention “*is based on the viewer answering a query*” (emphasis added). This is clearly distinguishable from passive monitoring as with Herz.

Further, it is asserted in the Office Action that Herz teaches receiving feedback as the profile is updated after a viewer watches or doesn’t watch programming, not that the feedback is based on the viewer answering a query. Moreover, once the particular viewer profile of Herz is

updated, the previous existing profile of the particular viewer does not exist. Therefore, Herz cannot teach or suggest “*the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer*, wherein *the feedback is based on the viewer answering a query*” (emphasis added) as required, in part, by amended claims 20, 28 and 32.

Williams discloses that after a viewer is prompted with a list of recommended shows based on preferred genre, the viewer is prompted whether to record a suggested show or not. If the viewer does not view or record a program, the system will monitor viewing habits and subsequently provide a different list of programs at a later time.

Even if the teachings of Williams are combined with those of Herz, the result would still not teach or suggest “presenting the viewer with a second list including alternative TV programs available for viewing, the alternative programs selected in accordance with an alternative viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer*, wherein *the feedback is based on the viewer answering a query*” (emphasis added) as required, in part, by amended claim 20,

presenting the viewer with one of a first list of the selected programs and an alternative second list of programs, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the*

*second list remain available to the viewer, wherein the second list is based on feedback input from the viewer of the first list resulting from a query* (emphasis added)

as required, in part, by amended claim 28, or “presenting the viewer with a second list of selected programs based on said feedback input, *the second list arranged in accordance with an alternate viewer characteristics information profile, wherein the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer after receiving the feedback input from the viewer based on the query*” (emphasis added) as required, in part, by amended claim 32.

Further, the assertions made in the Office Action on pages 3-6 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2142 cannot be found. Additionally, since Herz, Williams, and therefore, nor the combination of the two, do not teach, disclose or suggest all the limitations of amended claims 20, 28 and 32, as listed above, amended claims 20, 28 and 32 are not obvious over Herz in view of Williams since a *prima facie* case of obviousness has not been met under MPEP §2143. Additionally, the claims that directly or indirectly depend from amended claims 20 and 28, namely, claims 21-27, 33-34 and 36, and 29-32, respectively, would also not be obvious over Herz in view of Williams for at least the same reason.

Accordingly, withdrawal of the rejection of claims 20-34 and 36 is respectfully requested.

Applicant's new claim 38 requires, in part, that "the alternative characteristics information profile is *selected from a fixed set of profiles*" (emphasis added). In Herz, however, the second profile is a modification of the first profile; or a viewer can attempt to use someone else's profile. Regardless of the case, in Herz the alternative profile is not fixed, and a fixed set of profiles do not exist for an alternative profile. Williams only teaches that a viewer is prompted to record a show or not. Therefore, the combination of Herz and Williams cannot teach or suggest that "the alternative characteristics information profile is *selected from a fixed set of profiles*" (emphasis added). Thus, new claim 38 is patentable over the combination of Herz and Williams.

Additionally, new claim 39 requires, in part, "*the fixed set of profiles is based on demographics*" (emphasis added). New claim 40 requires, in part, "the alternative characteristics information profile is created based on *a random selection from the fixed set of profiles*" (emphasis added). New claim 41 requires, in part, "the alternative characteristics information profile is *created by randomly selecting profile parameters from the fixed set of profiles*" (emphasis added). New claim 42 requires, in part, "*the fixed set of profiles is one of pre-created and pre-captured*" (emphasis added). As Herz does not teach that an alternative profile can coexist where the alternative profile is selected from a fixed set, Herz cannot teach the additional limitations required, in part, by new claims 39-42. Therefore, new claims 39-42 are patentable over Herz in view of Williams for at least these reasons.

*Claims 35 and 37*

Rejection of claims 35 and 37 is respectfully traversed because, for at least the following reasons, Herz, Williams and Wugofski, whether considered separately or in combination, fail to show or suggest all of the claimed limitations.

Claims 35 and 37 directly depend on amended claim 20. As asserted above, the combination of Herz and Williams does not teach or suggest the limitations of “presenting the viewer with a second list including alternative TV programs available for viewing, the alternative programs selected in accordance with an alternative viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer, wherein the feedback is based on the viewer answering a query*” (emphasis added) as required, in part, by amended claim 20.

Wugofski is relied on for disclosing a GUI showing different channels available for selection. Even if the teachings of Wugofski is combined with those of Herz and Williams, the result would still not teach or suggest “presenting the viewer with a second list including alternative TV programs available for viewing, the alternative programs selected in accordance with an alternative viewer characteristics information profile, wherein *the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer, wherein the feedback is based on the viewer answering a query*” (emphasis added) as required, in part, by amended claim 20.



Further, the assertions made in the Office Action on page 7 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2142 cannot be found. Additionally, since Herz, Williams, Wugofski, and therefore, nor the combination of the three, do not teach, disclose or suggest all the limitations of amended claim 20, as listed above, amended claim 20 is not obvious over Herz in view of Williams, and further in view of Wugofski since a *prima facie* case of obviousness has not been met under MPEP §2143. Additionally, the claims that directly depend from amended claim 20, namely, claims 35 and 37, would also not be obvious over Herz in view of Williams, and further in view of Wugofski for at least the same reason.

Accordingly, withdrawal of the rejection of claims 35 and 37 is respectfully requested.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests that the rejections of the claims be withdrawn, and that the case be passed to issue. If the Examiner feels that a telephone interview would be helpful to the further prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

Please direct all correspondence to **Myers Andras Sherman LLP**, 19900 MacArthur Blvd., 11<sup>th</sup> Floor, Irvine, California 92612.

Respectfully submitted,

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